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OFFICE OF PETITIONS

In re Application of :
NOTO et al. : DECISION ON APPLICATION
Application No. 09/775,970 : FOR
Filed: February 2, 2001 : PATENT TERM ADJUSTMENT
Attorney Docket No. 2557-001 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN THE NOTICE OF ALLOWANCE UNDER 35 U.S.C. § 154(b)(3)(B)(ii) AND 37 C.F.R. § 1.705(b)," filed April 6, 2005. Applicants request that the patent term adjustment be corrected to nine hundred twenty-two (922) days plus the period from the filing of this request until the date of issue. This request is made in part on the basis that the Office will take more than three years to issue the patent.

The request for reconsideration of the patent term adjustment at the time of mailing of the notice of allowance is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is seven hundred five (705) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

However, a decision on the request for reconsideration of the patent term adjustment indicated in the notice of allowance as it relates to the Office's failure to issue the patent within 3 years of the filing date is being **held in abeyance** until after

the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentees may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

On January 26, 2005, the Office mailed the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days. On April 6, 2005, applicants timely submitted an application for patent term adjustment (with required fee). In effect, applicants dispute the reduction of 364 days for applicant delay in responding to the restriction requirement mailed February 6, 2003. Further, applicants request entry of a period of adjustment of 394 days for Office delay in taking action in response to their response filed April 1, 2003.

Applicants state that the patent issuing from this application is not subject to a terminal disclaimer.

Applicants are correct that the reduction of 364 is incorrect. A review of the application history reveals that applicants' response to the non-final Office action mailed February 6, 2003, is considered filed on April 1, 2003, reflecting timely filing for purposes of compliance with 37 CFR 1.704(b). The record further shows that a request for reconsideration of the abandonment was filed on December 11, 2003 (and resubmitted on May 4, 2004), within 2 months of the mailing of the notice of abandonment. See also § 1.704(c)(4).

Moreover, applicants are correct that the application is entitled to additional patent term for Office delay in taking action in response to the amendment filed April 1, 2003. Specifically, the Office mailed a non-final rejection on August

30, 2004, four months and 395 (not 394) days later. The period of adjustment is 395 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is seven hundred five (705) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of adjusted PAIR calculation